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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LY, ANH

ART UNIT PAPER NUMBER

2172

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/552,131

Applicant(s)

MELKOTE ET AL

Examiner

Anh Ly

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 24-36 are objected to because of the following informalities: The first line of claims from 24-36, "A method as recited in claim 23" replace with –A system as recited in claim 23." Appropriate corrections are required.
2. Claims 1-41 are pending in this application.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-3, 7, 9, 17-18, 21-22, 37-38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,157,947 issued to Watanabe et al. (herein Watanabe).

With respect to claim 1, Watanabe discloses forming an invention disclosure online by entering a plurality of selected information into a web-based system (see figs 4 and 5, IP and firewall); as the plurality of selected information is entered, storing the information in a central storage location; and allowing access to various users for reviewing the information (see abstract, col. 1, lines 8-14 and lines 38-67, col. 2, lines 1-39).

Watanabe does not clearly disclose "an invention disclosure online, storing the information in a central storage location and allowing access to various users." But, however, Watanabe shows intellectual property is registered with a disclosure and the registered information is stored on memory on the web server system and users can be access to it and display or review it (see abstract, figs 4 and 5, col. 1, lines 38-67, col. 2, lines 1-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Watanabe such as intellectual property disclosure, memory, firewall, and web server so as to obtain a

method of forming and displaying and accessing the invention disclosure via Internet in the legal practical services environment.

With respect to claims 2-3, Watanabe discloses step of forming includes providing identification information; whereby upon providing identification information to said web-based server; and retrieving user information from the directory system in response to the identification information (user ID and password: col. 18, lines 35-61); and step of prompting the user for classification information (Intellectual Property (IP) ID (IP ID: col. 11, lines 20-67 and col. 12, lines 1-67).

With respect to claims 7 and 9, Watanabe discloses ranking the disclosure; and prompting a patentability review from the patent staff person (col. 11, lines 20-67 and col. 12, lines 1-67; and col. 2, lines 1-39).

Claim 17 is essentially the same as claim 1 except that it is directed to a system rather than a method (see abstract, col. 1, lines 8-14 and lines 38-67, col. 2, lines 1-39; col. 5,20-61, col. 7, lines 35-67, col. 8, lines 1-9, see figs 10, 11 and 16), and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 18 is essentially the same as claim 2 except that it is directed to a system rather than a method (user ID and password: col. 18, lines 35-61), and is rejected for the same reason as applied to the claim 2 hereinabove.

With respect to claims 22-21, Watanabe discloses user computer comprises a CAD file viewer (col. 10, lines 10-40 and col.12, lines 30-60); and wherein said server comprises a web single login (col. 18, lines 35-61).

With respect to claim 37, Watanabe disclose entering identification information retrieving user information from a directory system in response to said identification information entering disclosure information to create an invention disclosure; coupling said user information with said disclosure; and storing the disclosure in a database (see abstract, col. 1, lines 8-14 and lines 38-67, col. 2, lines 1-39).

Watanabe does not clearly disclose "an invention disclosure online, storing the information in a central storage location and allowing access to various users." But, however, Watanabe shows intellectual property is registered with a disclosure and the registered information is stored on memory on the web server system and users can be access to it and display or review it (see abstract, figs 4 and 5, col. 1, lines 38-67, col. 2, lines 1-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Watanabe such as intellectual property disclosure, memory, firewall, and web server so as to obtain a method of forming and displaying and accessing the invention disclosure via Internet in the legal practical services environment.

With respect to claim 38 and 41, Watanabe discloses prompting the user for classification information; and prompting a patentability review from the patent staff person (col. 11, lines 20-67 and col. 12, lines 1-67; col. 12, lines 1-67; and col. 2, lines 1-39).

6. Claims 4-6, 8, 10-15, 19-20, 23-35, and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,157,947 issued to Watanabe et al. (herein Watanabe) in view of US Patent No. 5,987,464 issued to Schneider.

With respect to claims 4-6 and 8, Watanabe discloses a method of forming an on-line invention disclosure as discussed in claim 1.

Watanabe does not explicitly indicate, "notifying an evaluator in response to the classification information; prompting an evaluation from the evaluator; generating an E-mail; providing a hyperlink to the disclosure in the E-mail; notifying a patent staff person in response to the classification information; prompting an evaluation comprises scheduling an evaluation meeting."

However, Schneider discloses notifying to the user via e-mail, and hyperlink, and scheduler as claimed (col. 1, lines 15-26, col. 4, lines 62-67, col. 5, lines 1-9, col. 6, lines 8-25, col. 7, lines 26-45, col. 10, lines 12-49 and col. 12, lines 1-33; col. 18, lines 40-67 and col. 19, lines 1-8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Schneider so as to obtain a method of forming an on-line invention disclosure because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

With respect to claims 10-15, Watanabe discloses a method of forming an on-line invention disclosure as discussed in claim 1. Also Watanabe discloses displaying and user ID and password as claimed (col. 2, lines 1-39 and col. 18, lines 35-61).

Watanabe does not explicitly indicate, "a database coupled to a web server; identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system; notifying comprises the step of generating an E-mail having a hyperlink therein; providing a status update via E-mail."

However, Schneider discloses database connecting with web server, notifying to the user via e-mail, hyperlink as claimed (see fig. 11, col. 3, lines 59-67, col. 4, lines 1-8, col. 10, lines 12-49, col. 15, lines 52-67, col. 16, lines 1-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Schneider so as to obtain a method of forming an on-line invention disclosure because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

With respect to claims 19-20, Watanabe discloses a system of forming an on-line invention disclosure as discussed in claim 17.

Watanabe does not explicitly indicate, "wherein said server comprises a web server and a web browser."

However, Schneider discloses web server and web browser as claimed (see fig. 11, col. 15, lines 52-67 and col. 16, lines 1-33).



Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Schneider so as to obtain a method of forming an on-line invention disclosure because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

With respect to claim 23, Watanabe discloses forming an invention disclosure online by entering a plurality of selected information into a web-based system; as the plurality of selected information is entered, storing the information in a central storage location; allowing access to various users to access the information; prompting the user for classification information (abstract, col. 1, lines 8-14 and lines 38-67, col. 2, lines 1-39; col. 5, 20-61, col. 7, lines 35-67, col. 8, lines 1-9, see figs 10, 11 and 16).

Watanabe does not explicitly indicate, "notifying an evaluator; and prompting an evaluation from the evaluator."

However, Schneider discloses notifying and evaluating as claimed (col. 18, lines 40-67 and col. 19, lines 1-9 and lines 50-65).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Schneider so as to have an system of invention disclosure submission because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

With respect to claim 24, Watanabe discloses forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in response to the identification information (col. 18, lines 35-61; col. 11, lines 20-67 and col. 12, lines 1-67).

With respect to claims 25-29, Watanabe discloses a system of invention discloses submission as discussed in claim 23. and Watanabe discloses ranking and displaying for review (col. 11, lines 20-67 and col. 12, lines 1-67; and col. 2, lines 1-39).

Watanabe does not explicitly indicate, "notifying an evaluator comprises the step of generating an E-mail; providing a hyperlink to the disclosure in the E-mail; prompting an evaluation comprises scheduling an evaluation meeting; and prompting an evaluation comprises ranking the disclosure."

However, Schneider discloses notifying to the user via e-mail, and hyperlink, and scheduler as claimed (col. 1, lines 15-26, col. 4, lines 62-67, col. 5, lines 1-9, col. 6, lines 8-25, col. 7, lines 26-45, col. 10, lines 12-49 and col. 12, lines 1-33; col. 18, lines 40-67 and col. 19, lines 1-8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Schneider so as to obtain an invention disclosure submission system because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

With respect to claim 30-35, Watanabe discloses a submission invention disclosure system as discussed in claim 23. Also Watanabe discloses displaying and user ID and password as claimed (col. 2, lines 1-39 and col. 18, lines 35-61).

Watanabe does not explicitly indicate, "central location comprises a database coupled to a web server; identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system; notifying comprises the step of generating an E-mail having a hyperlink therein; viewing the status of the invention disclosure on-line; providing a status update via E-mail."

However, Schneider discloses database connecting with web server, notifying to the user via e-mail, hyperlink as claimed (see fig. 11, col. 3, lines 59-67, col. 4, lines 1-8, col. 10, lines 12-49, col. 15, lines 52-67, col. 16, lines 1-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Schneider so as to obtain a method of forming an on-line invention disclosure because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

With respect to claim 39-40, Watanabe discloses a method of submitting documents as discussed in claim 37.

Watanabe does not explicitly indicate, "notifying an evaluator in response to the classification information; prompting an evaluation from the evaluator; and notifying a patent staff person in response to the classification information."

However, Schneider discloses notifying an evaluator and notifying to a patent staff as claimed (col. 1, lines 15-26, col. 4, lines 62-67, col. 5, lines 1-9, col. 6, lines 8-25, col. 7, lines 26-45, col. 10, lines 12-49 and col. 12, lines 1-33; col. 18, lines 40-67 and col. 19, lines 1-8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Schneider so as to obtain a method of submitting documents because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

7. Claims 16 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,157,947 issued to Watanabe et al. (herein Watanabe) in view of US Patent No. 5,329,447 issued to Leedom, Jr. (herein Leedom).

With respect to claim 16, Watanabe discloses a method of forming an on-line invention disclosure as discussed in claim 1.

Watanabe does not explicitly indicate, "accepting a paper submission; and wherein the step of forming comprises scanning said paper submission into the database."

However, Leedom discloses paper associated with law case and scanning system as claimed (col. 4, lines 52-67, col. 5, lines 1-12, col. 10, lines 8-34 and col. 15, lines 21-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Leedom so as to obtain a method of forming an on-line invention disclosure because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

With respect to claim 36, Watanabe discloses an invention disclosure submission system as discussed in claim 23.

Watanabe does not explicitly indicate, "accepting a paper submission; and wherein the step of forming comprises scanning said paper submission into the database."

However, Leedom discloses paper associated with law case and scanning system as claimed (col. 4, lines 52-67, col. 5, lines 1-12, col. 10, lines 8-34 and col. 15, lines 21-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Leedom so as to have a system of invention disclosure submission because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

**Contact Information**

8. Any inquiry concerning this communication should be directed to Anh Ly whose telephone number is (703) 306-4527. The examiner can be reached on Monday - Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner are unsuccessful, see the examiner's supervisor, Kim Vu, can be reached on (703) 305-4393.

Any response to this action should be mailed to:

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Washington, D.C. 20231

or faxed to:

(703) 746-7238 (after Final Communication)

or:

(703) 746-7239 (for formal communications intended for entry)

or:

(703) 746-7240 (for informal or draft communications, or Customer Service Center, please label "PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (receptionist).

Inquiries of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

AL 

  
JEAN M. CORRIELUS  
PRIMARY EXAMINER

Jul. 26<sup>th</sup>, 2002.